

### **REMARKS**

In response to the Official Action mailed July 21, 2005, Applicants amend their application and request reconsideration. Claims 1-24 stand rejected. In this Amendment, claims 25-27 are added so that claims 1-27 are now at issue. Claims 25-27 are supported by the specification, for example, at page 11, and thus no new matter has been added.

#### **I. 35 U.S.C §103(a) Obviousness Rejection of Claims**

Claims 1-24 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Manning* (U.S. Patent No. 6,043,826) in view of *Keskar* et al. (U.S. Patent No. 6,829,668, hereinafter "*Keskar*"). Applicants respectfully traverse this rejection and respectfully request reconsideration.

To establish a *prima facie* case of obviousness, the cited references teach or suggest all the claim limitations. MPEP §2143. The rejection of claim 1 under §103(a) is improper as the combination of *Manning* and *Keskar* does not teach or suggest all of the claim limitations. For example, the combination of *Manning* and *Keskar* fails to teach or suggest returning a modified document to a computer. The Examiner asserts that this limitation is taught by *Keskar* at col. 7, lines 55-65, which states:

The relationship agents 122, 124, 126 also search for and establish relationships for items that are first created in a handheld device section 200 and subsequently synchronized. When items are synchronized from the handheld device section 200 to the desktop section 100, they are placed in designated applications or places. For example, contacts, calendar/appointment items, memos, to-do list items may go to an application such as Microsoft Outlook. When a new item is created on the handheld device section 200, and then synchronized with the desktop

section 100, the various relation agents automatically see the new item and process it.

With respect to this passage, the Examiner contends “synchronizing the new item created on the handheld device section with the desktop section implies that modified documents with new items are returned to the desktop computer.” (See page 4, lines 1-4 of the Official Action).

Applicants respectfully correct the Examiner’s mischaracterization of *Keskar* by noting that there are not “documents with new items.” According to *Keskar*, documents **are** items and thus documents do not have items, new or otherwise. (Col. 4, lines 55-57 of *Keskar*). Thus, the Examiner’s contention that *Keskar* teaches that “modified documents with new items are returned to the desktop computer” is erroneous. For at least this reason, *prima facie* obviousness has not been established, and claim 1 is patentable over the combination of *Manning* and *Keskar*.

Furthermore, the combination of *Manning* and *Keskar* fails to teach or suggest, for example, determining by the computer one or more modifications between the original document and the modified document, as recited by claim 1. The Examiner asserts that this limitation is again taught by *Keskar* at col. 7, lines 55-65, recited above. With respect to this passage, the Examiner contends that “the fact that the various relation agents automatically see the new item and process it shows that one modification, which means the new item, between the original document and the modified document is determined.” (See page 4, lines 5-9 of the Official Action) (emphasis in original). That contention is erroneous because, as previously explained, *Keskar* states that items are in fact documents. (Col. 4, lines 55-57 of *Keskar*). Thus the “new item” is merely a new document, and not a modification to an original document as the Examiner incorrectly contends. Moreover, “see the new item and process it” in *Keskar* does not teach “determine modifications.” The phrase “see the new item and process it” in *Keskar* means that

the relations agents look for relationships among the different items (documents). (Col. 8, lines 1-4 of *Keskar*). Accordingly, *Manning* and *Keskar*, alone or in combination, fail to teach or suggest all of the limitations of claim 1. For at least this reason, *prima facie* obviousness has not been established, and claim 1 is patentable over the combination of *Manning* and *Keskar*.

Claims 9 and 17 recite limitations similar to claim 1, and are thus patentable for at least the same reasons as given for claim 1. Claims 2-8, 10-16, and 18-24 depend from claims 1, 9, and 17, respectively, and are therefore patentable for at least the same reasons as given for claim 1, 9, and 17.

Still further, the combination of *Manning* and *Keskar* fails to teach or suggest all of the limitations of claim 2. For example, the combination fails to teach or suggest that determining modifications includes “utilizing change tracking software.” The Examiner contends that because documents in *Manning* are allegedly modified, this modification “implies that a software [sic] for tracking modification is used.” Because the Examiner alleges this limitation is implicit, the Examiner’s contention is tantamount to a rejection based on inherency. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The rejection is therefore erroneous at least because the Examiner fails to demonstrate why the modification of documents necessarily requires the use of change tracking software. Moreover, the rejection is further erroneous because the modification of documents **does not necessitate** the use of change tracking software. When modifying a documents, one does not necessarily, for example, make comparisons to the original document so as to identify and indicate those changes. (See page 11, lines 11-22 of the patent

application). For at least this reason, *prima facie* obviousness has not been established, and claim 2 is patentable over the combination of *Manning* and *Keskar*. Claims 10 and 18 recite limitations similar to claim 2 and are thus patentable for at least the same reasons as given for claim 2.

Still further, the combination of *Manning* and *Keskar* fails to teach or suggest all of the limitations of claim 6. For example, the combination fails to teach or suggest merging the original document and the modified document. The Examiner contends the fact that the relations agent of *Keskar* searches through the document and encounters newly created items “implies that the modified document, which is the newly created item, is merged into the original document.” Official Action at p. 6. Applicants note that, contrary to the Examiner’s assertion, col. 19-55 of *Keskar* says nothing to suggest that relations agents search through a document. The agents search between and among documents, not in the documents themselves. (Col. 8, lines 1-4 of *Keskar*). Moreover, as previously discussed, a “new item” is not a modified document. Also, because the Examiner alleges this limitation is implicit, the Examiner’s contention is again tantamount to a rejection based on inherency. The rejection is thus erroneous at least because the Examiner has failed to demonstrate why “encounters newly created items” necessarily requires merging. Moreover, the rejection is further erroneous because encountering newly created items (documents) **does not necessitate** a merging of documents because modified documents may be written over original documents instead of merging modifications into the original document. For at least this reason, *prima facie* obviousness has not been established, and claim 6 is patentable over the combination of *Manning* and *Keskar*. Claims 14 and 22 recite limitations similar to claim 6 and are thus patentable for at least the same reasons as given for claim 6.

New claims 25-27 are directed to specific embodiments of the change tracking feature of the present invention, and are thus patentable for at least the same reasons as given for claims 2, 10, and 18.

**CONCLUSION**

In view of the above amendments and remarks, Applicant submits that all claims are clearly allowable over the cited prior art, and respectfully requests early and favorable notification to that effect.

Respectfully submitted,

Dated: October 17, 2005

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